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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,902	11/27/2001	Tomohiro Takefuji	740165-319	7650

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EXAMINER

LAZOR, MICHELLE A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/993,902

Applicant(s)

TAKEFUJI ET AL

Examiner

Michelle A Lazor

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Claims 8 – 12 in Paper No. 6 is acknowledged.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by McClinton et al. (U.S. Patent No. 4533568).

McClinton et al. disclose a mask (12) having a shape that corresponds to the surface shape of a coated portion molding member (10), wherein the mask (12) is formed by using the coated-portion molding member (10), and covers parting surfaces of the coated-portion molding member (10) in the state in which the mask (12) is mounted to the coated-portion molding member (10) (Figure 1; Abstract and column 2, lines 31 – 47). Thus McClinton et al. disclose all the limitations of Claim 8, and anticipate the claimed invention.

4. Claims 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Zimmerman et al. (U.S. Patent No. 4940012).

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Zimmerman et al. disclose a mask (60) having a shape that corresponds to the surface shape of a coated portion molding member (16), wherein the mask (60) is formed by using the coated-portion molding member (16), and covers parting surfaces of the coated-portion molding member (16) in the state in which the mask (60) is mounted to the coated-portion molding member (16) (Figures 1 – 3; column 4, lines 41 – 54) and adjusting portions which are fixed to at least the peripheries or the facing portions of mask bodies, and whose portions fixed to the mask bodies are formed in correspondence with shapes of the parting surfaces (column 5, lines 17 – 36). Thus Zimmerman et al. disclose all the limitations of Claims 8 and 9, and anticipate the claimed invention.

5. Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Gobled et al. (U.S. Patent No. 6548000).

Gobled et al. disclose a mask (20) having a shape that corresponds to the surface shape of a coated portion molding member, wherein the mask (20) is formed by using the coated-portion molding member, and covers parting surfaces of the coated-portion molding member in the state in which the mask (20) is mounted to the coated-portion molding member (Figures 6 – 9; column 3, lines 38 – 59) and adjusting portions, considered to include bonding or adhesive means, which are fixed to at least the peripheries or the facing portions of mask bodies, and whose portions fixed to the mask bodies are formed in correspondence with shapes of the parting surfaces (column 3, lines 43 – 46). Thus Gobled et al. disclose all the limitations of Claims 8 and 9, and anticipate the claimed invention.

*Allowable Subject Matter*

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6. Claims 10 – 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There was no reference in the prior art search that disclosed, taught, or suggested adjusting portions formed by time-hardening members that harden after an elapse of a predetermined period of time, wherein the time-hardening members can tightly contact the mask bodies, can be plastically deformed and partially cut off by an external force applied thereof, and are integrally bonded to the mask bodies by hardening while adhering to the mask bodies.

### *Conclusion*

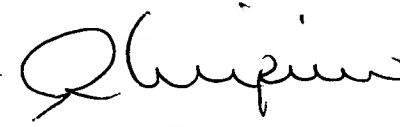
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 703-305-7976. The examiner can normally be reached on Mon - Thurs 6:30 - 4:00, Fridays 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



MAL



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